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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,717	01/30/2004	Erik J. van der Burg	MVMDINC.1CP1C4	5133

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EXAMINER
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DAWSON, GLENN K

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/768,717

Applicant(s)

VAN DER BURG ET AL.

Examiner

Glenn K. Dawson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06-15-2006.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06-15-2006 has been entered.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Ostrovsky, et al.-6447530.

Ostrovsky discloses an implantable device in fig. 29-35 having spokes 202 and barbs 206. The spokes expand from a linear configuration when constrained within a sheath 224, to an expanded diameter configuration as shown in fig. 29. The device is releasably attached to a deployment line 218 inside of a delivery catheter 226 inside the sheath 224- see fig. 32. As shown in fig. 32, the implantable device is capable of

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attaining a configuration having a small diameter at its two ends-204, 212 and rises to a central apex therebetween. A tube 216 extends from the distal end inside the filter towards the proximal end. As explained in col. 10 lines 49-56, even though the device is generally a means to remove a filter, the steps could be reversed in order to implant a filter. The device as shown in fig. 32 is also a fully expanded state. In this configuration, the claimed limitations are met.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrovsky, et al.-'530 in view of Brooks, et al.-6346116 and Tsugita, et al.-5911734.

Ostrovsky discloses the invention as claimed with the exception of the material of the filter having a membrane and the material of the membrane being ePTFE.

Tsugita discloses that it was known to provide a filter with a membrane. It would have been obvious to have placed a membrane on the filter of Ostrovsky, as this provides an effective means to filter out undesirable particles while allowing blood-flow therethrough. It also would have been obvious to have placed the membrane on the proximal face of the filter because as taught and shown by Tsugita in fig. 6b and col. 12 lines 11-28, if introduced in a retrograde orientation this allows the interior of the mesh to be directed upstream to collect debris. The filter is located distal of the delivery catheter.

Brooks discloses in col. 4 that it was known to use ePTFE as a filter material. It would have been obvious to have used ePTFE as the filter material as this effectively filters particles out of blood.

### ***Response to Arguments***

Applicant's arguments filed 06-15-2006 have been fully considered but they are not persuasive.

As pointed out above the embodiment of Ostrovsky shown in fig. 32 includes the shape claimed. This configuration shows the filter in a fully expanded state. It is no larger in fig. 29.


Applicant argues that Ostrovsky and Tsugita should not be combined because they deal with different medical conditions. Ostrovsky discloses in col. 3 lines 17-20 that the device can be used with stents. Both of these devices are used to filter blood of thrombotic material and therefore are analogous art. Placing the membrane of Tsugita on the filter of Ostrovsky would in no way destroy the device or its intended use. Gelbfish-5800457 discloses that it was known to place a membrane on the proximal side of a vena cava filter. There is no evidence that the placing of the membrane on the proximal end of Ostrovsky's filter would be unsuccessful at filtering out thrombus from the blood. Applicant also argues that Ostrovsky's device cannot move from its reduced cross-section configuration to its enlarged one while the proximal hub remains distal to the distal end of the deployment catheter. This is not found persuasive because catheter 222 could easily be moved distally and cause the filter to attain its reduced diameter configuration and then withdrawn to allow it to enlarge, all the while the proximal hub would remain distal to the distal end of the deployment catheter. All of the claimed structure is disclosed in the references and capable of performing the intended functions or attaining the claimed states or configurations.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K. Dawson whose telephone number is 571-272-4694. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Glenn K Dawson  
Primary Examiner  
Art Unit 3731

Gkd  
23 July 2006